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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,689	02/05/2004	R. Dennis Nesbitt	P-5060-D1	5140

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THE TOP-FLITE GOLF COMPANY, A WHOLLY OWNED
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CARLSBAD, CA 92008-7328

EXAMINER

GORDON, RAEANN

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,689

Applicant(s)

NESBITT, R. DENNIS

Examiner

Raeann Gorden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 17-23 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-13 and 17-23 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claims 1 and 17, EPR, EPDM, and mixtures thereof are not currently listed in the specification. Please note if applicant chooses to add the subject matter to the specification the application will be considered a CIP and a new oath/declaration will be required. The subject matter is original to the instant application, which is a DIV, but not to the parent application.

Claim 5, the cover Shore D hardness from 35 to 90 is not supported by the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 11, 13, 17-20, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shama (4,848,770) in view of Crompton (3,239,228).

Regarding claim 1, Shama discloses a golf ball comprising a center core, a mantle layer

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(applicant's outer core layer) and a cover. The center core is made from a sulfur cured natural rubber or cis-1,4 polybutadiene (col. 2, lines 1-12). The mantle layer is disposed over the center core and comprises a cis-1,4 polybutadiene and peroxide (table 1). A cover is formed over the mantle layer (abstract). Shama does not explicitly disclose a sulfur cured polybutadiene. However, Crompton teaches a golf ball core comprising a sulfur cured polybutadiene. Regarding claim 2, Shama discloses the center core has a diameter from 0.70 to 1.25 inches (table 5). Regarding claim 3, the center core does not include carboxylic acid salt (table 1). Regarding claim 4, the mantle layer has a diameter from 1.49 to 1.56 inches (table 7). Regarding claim 5, the cover has a Shore D hardness from 38 to 64 or (60 to 95 Shore C) (table 8). Regarding claim 6, the center core comprises a polybutadiene with at least 97% cis-1,4 structure (col. 2, lines 15-17). Regarding claim 7, the center core has a specific gravity from 1.30 to 1.5 (table 5). Regarding claim 11, the center core includes an initiator (accelerator) (col 1, lines 65-68). Regarding claim 13, the peroxide is dicumyl peroxide (table 1). Regarding claim 17, Shama discloses a golf ball comprising a center core, a mantle layer (applicant's outer core layer) and a cover. The center core is made from a sulfur cured natural rubber or cis-1,4 polybutadiene (col. 2, lines 1-12). The center has a Shore A hardness from 84 to 100 or (Shore C 50 to 95) (table 5). The mantle layer is disposed over the center core and comprises a cis-1,4 polybutadiene and peroxide. The mantle layer has a Shore D hardness from 30 to 64 or (Shore C 50 to 95) (table 1). A cover is formed over the mantle layer (abstract). Shama does not explicitly disclose a sulfur cured polybutadiene. However, Crompton teaches a golf ball core comprising a sulfur

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cured polybutadiene. Regarding claim 18, the center core comprises a polybutadiene with at least 97% cis-1,4 structure (col. 2, lines 15-17). Regarding claim 19, Shama discloses any polybutadiene rubbers with at least a 90% cis 1,4 structure may be used (col. 2, lines 14-18). Regarding claim 20, the center core does not include carboxylic acid salt (table 1). Regarding claim 22, the peroxide is dicumyl peroxide (table 1). Regarding claim 21, the center core includes an initiator (accelerator) (col 1, lines 65-68). One of ordinary skill in the art would have modified Shama in view of Crompton for enhanced resilience.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shama in view of Aoyama (5,688,192). Shama discloses the invention as shown above but fails to include foamed or cellular material as a filler type. Aoyama teaches cellular filler. One skilled in the art would have included a cellular filler to achieve the desired weight of the golf ball. In regards to claim 8, Shama discloses that any well known filler may be added to achieve the desired specific gravity. One skilled in the art would lower the specific gravity to make the ball lighter.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 and 17-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,695,718. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application are encompassed by the claims of the '718 patent. Including additional materials for the core layer does not render a patentable distinction.

Response to Arguments

Applicant's arguments filed 8-19-04 have been fully considered but they are not persuasive. With respect to the specification objection, applicant did not respond to the materials, EPR, EPDM, etc, the objection is maintained. Since the Shore D hardness for the cover (claim 5) is in the parent applicant is advised to amend the specification to include the subject matter.

In regards to the prior art rejection applicant's arguments are not persuasive. The sulfur cured core is not new or innovative in the golfing art. Shama clearly suggest the use of sulfur in the core but does not explicitly disclose it in combination with the polybutadiene. The secondary reference, Crompton is cited to teach that core polybutadiene and sulfur is clearly old and well-known in the art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 571-272-4409. The examiner can normally be reached on Mon, Tues, Thurs, Fri 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

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RG
July 19, 2005



RAEANN GORDEN
PRIMARY EXAMINER